

The opinion in support of the decision being entered today was ***not*** written for publication and is ***not*** binding precedent of the Board.

Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK JURY

Appeal No. 1999-2509
Application 08/752,917

HEARD: February 7, 2002

Before WARREN, KRATZ and POTEATE, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner finally rejecting claims 14 through 25, 38, 39, 41 and 42. Appellant has withdrawn the appeal with respect to claims 26 through 37, 40, 43 and 44, all of the remaining claims of record, and thus the appeal as to these claims is dismissed. Claim 14 is illustrative of the claims on appeal:

14. The product of a process comprising feeding a particulate chocolate and feeding a particulate confectionery composition comprising a syrup into an extruder to obtain a mixture in the extruder and applying pressure to the mixture to pass the mixture through the extruder and to and through an extruder die to obtain an extrudate from the die, wherein the mixture passed through the extruder and the extrudate from the die are at a temperature so that the mixture and extrudate are in a non-pourable state, so that the chocolate and the confectionery composition of the mixture plastically deform so that the confectionery composition forms veins interspersed within the chocolate and then obtaining extrudate from the die for obtaining the product.

The appealed claims, as represented by independent claim 14, are drawn in product-by-process format to a chocolate candy product having veins of a confectionery composition comprising a syrup interspersed within the chocolate, that has been prepared by a process comprising mixing particulate chocolate and particulate confectionery composition in an extruder and passing the mixture through the die of the extruder, while maintaining the mixture in a non-pourable state by controlling the temperature. The confectionery composition comprising a syrup can be a toffee (e.g., claim 17) or a caramel (e.g., claim 18). In independent claim 41, a candy product prepared from a particulate chocolate substitute comprising a cocoa butter replacement or a particulate chocolate analogue comprising a cocoa butter replacement and a particulate confectionery composition comprising a syrup is prepared by the same process. According to appellant, the claimed candy product “is an intimate mixture of chocolate together with a chewy sweet component . . . which is not homogeneous” as the “chocolate matrix . . . [has] veins or strands of chewy sweet dispersed therein and has a unique texture which combines the smooth mouthfeel and bite of the chocolate with the flavor and chewy texture of the chewy sweet” (specification, page 2).

The references relied on by the examiner are:

Wedin	2,334,052	Nov. 9, 1943
Pelletier	2,874,649	Feb. 24, 1959
Cloud et al. (Cloud)	4,357,359	Nov. 2, 1982
Butcher et al. (Butcher)	4,873,104	Oct. 10, 1989
Mackey	5,439,695	Aug. 8, 1995
Kehoe et al. (Kehoe)	5,626,892	May 6, 1997
		(filed Nov. 24, 1993)

The examiner has advanced the following grounds of rejection on appeal:

claims 14 through 25, 38, 39, 41 and 42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pelletier in view of Cloud and, if necessary, appellant’s admission at page 4 of the specification;¹ and

claims 14 through 25, 38, 39, 41 and 42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mackey in view of either Kehoe, Wedin or Butcher, each, if necessary, in view of appellant’s admission at page 4 of the specification.²

¹ The examiner states at page 4 of the answer, that “[r]egarding the recitation of cocoa butter substitutes, this component is conventionally known and in any event is admitted by the appellant to be commercially available on page 4 of the specification.”

Appellant states in the brief (page 3) that the appealed independent claims are separately patentable and that “all dependent claims stand or fall with the independent claim.” However, we fail to find in the brief or reply brief in their entirety, separate arguments for claims 14 and 41. Thus, we decide this appeal based on appealed claim 14. 37 CFR § 1.192(c)(7) (1997).

We reverse the ground of rejection based on Pelletier. We affirm the ground of rejection based on Mackey because we agree with the examiner's conclusion that the claimed subject matter would have been obvious over this reference, but denominate our affirmance as a new ground of rejection under 37 CFR § 1.196(b) (1997), since our reliance on Mackey materially differs from that of the examiner as set forth below and our position is not directly addressed by any of appellant's arguments in the brief or reply brief. *See In re Eynde*, 480 F.2d 1364, 1370-71, 178 USPQ 470, 474-75 (CCPA 1973).

Rather than reiterate the respective positions advanced by the examiner and appellant, we refer to the examiner's answer and to appellant's brief and reply brief for a complete exposition thereof.

Opinion

In order to consider the examiner's application of prior art to appealed claim 14, we must first interpret the claim in light of the written description in appellant's specification as it would be interpreted by one of ordinary skill in this art, *see In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997) (“[T]he PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification.”), without reading into these claims any limitation or particular embodiment which is disclosed in the specification. *See In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); *In re Priest*, 582 F.2d 33, 37, 199 USPQ 11, 15 (CCPA 1978). Thus, the terms in the appealed claim must be given their ordinary meaning unless another meaning is intended by appellant as established in the written description of the

² The examiner makes the same statement as set forth above in note 1, at page 6 of the answer.

specification. *See, e.g., Morris, supra; Zletz, supra* (“During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow. When the applicant states the meaning that the claim terms are intended to have, the claims are examined with that meaning, in order to achieve a complete exploration of the applicant’s invention and its relation to the prior art. *See In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969) (before the application is granted, there is no reason to read into the claim the limitations of the specification.).”).

It is apparent from the plain language of appealed claim 14 that the chocolate candy product is defined in product-by-process format, *see generally, In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985), according to which the confectionery composition comprising a syrup forms a plurality of “veins” that are “interspersed” in the chocolate during the coextrusion³ of a mixture of particles of chocolate and particles of said confectionary composition formed in the extruder through the die thereof, wherein the mixture is maintained in a non-pourable state by controlling the temperature so that the components of the mixture plastically deform. The term “veins” is, of course, plural, and since this term is not defined in appellant’s specification, it has the common, dictionary meaning of the word “vein” in which, in context, one substance is contained within another substance, such as “**4. Geol.** A regularly shaped and lengthy occurrence of an ore: lode. **5.** A long, wavy strip of color, as in wood or marble.”⁴ Thus, in context, the plural veins of the confectionary composition are “interspersed” in the chocolate, as the term “interspersed,” also undefined in the specification, has the common, dictionary meaning of “**1.** To distribute among other things at intervals. **2.** To supply or diversify with things distributed at intervals;”⁵ or of “**1.** To scatter among other things. **2.** To diversify or

³ We use the term “coextrusion” in its common, technical dictionary meaning of “[e]xtrusion-forming of plastic or metal products in which two or more compatible feed materials are used in physical admixture through the same extrusion die.” *McGraw-Hill Dictionary of Scientific and Technical Terms*, page 400 (Sybil P. Parker, ed., New York, McGraw-Hill, Inc. 1994).

⁴ *The American Heritage Dictionary, Second College Edition*, page 1340 (Boston, Houghton Mifflin Company, 1982); *Webster’s II New Riverside University Dictionary*, page 1279 (Boston, Houghton Mifflin Company. 1988).

⁵ *The American Heritage Dictionary, Second College Edition*, page 672.

supply with things distributed at intervals.”⁶ Indeed, the specification also describes the “veins” as “strands” and further states that the “surface finish . . . may have a marbled appearance” (specification, e.g., page 5, lines 25-26, and page 7, lines 7-10). There is no limitation on the number of veins or the dimensions thereof. Indeed, the scope of the claim can be seen from the disclosure that “it is possible to produce a few large strands . . . within the chocolate matrix or . . . it is possible to produce a very fine dispersion of veins or strands . . . within the chocolate matrix to give the appearance of a homogeneous product” (page 5, lines 28-33). The confectionery composition comprising a syrup can be, *inter alia*, toffee or caramel (specification, e.g., page 1, lines 27-34, and page 3, lines 21-24; and claims 17 and 18).

Accordingly, it is the claimed chocolate candy product encompassed by claim 14 in which at least two or more veins of the confectionery composition, that can be toffee and caramel, are interspersed in chocolate are produced by the plastic deformation of the particulate ingredients in admixture as they are coextruded in a non-pourable state through a single die, that must be compared with the prior art.

We first compare the claimed chocolate candy product of claim 14, as we have interpreted this claim, with the combined teachings of Pelletier and Cloud as applied by the examiner. It is the examiner’s position that the “shamrock” of Pelletier **Figs. 1 and 2** is made from two separate “inner” molds that “are shaped stands/veins” made of toffee, thus differing from the claimed candy product in the absence of chocolate, and in view of the teachings of Cloud to surround toffee with chocolate, it would have been obvious to use “chocolate in the outer mold of Pelletier to surround the toffee as taught by Cloud” (answer, page 4; see also pages 8 and 9-10). Indeed, Pelletier identifies the figure to which the examiner refers as a “club design” made from either a “composite mold form comprising a body portion and a tail portion” or from a “single piece mold” (col. 4, lines 60-64; see also col. 2, lines 30-34). Appellant submits that the composite mold for the “club design” in Pelletier does not form two veins that are interspersed in chocolate as required by appealed claim 14 and therefore, the combination of Pelletier and Cloud would not result in the claimed chocolate candy product, citing, *inter alia*,

⁶ *Webster’s II New Riverside University Dictionary*, page 628.

Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1050-54, 5 USPQ2d 1434, 1438-41 (Fed. Cir. 1988) (brief, pages 16-19).

We must agree with appellant since as shown in Pelletier, the “club design” is a unitary design in final form whether prepared by a composite mold or a single piece mold, and thus there is no other candy between the “body portion” and the “tail portion” of the composite mold. In view of the teachings of Cloud of coating toffee cores by immersion in chocolate, The combined teachings of these references would have resulted in the coating of the unitary “club design” with chocolate, which product would not fall within appealed claim 14. *Uniroyal, supra*. Thus, contrary to the examiner’s position, the combined teachings of Pelletier and Cloud would not have reasonably suggested to one of ordinary skill in this art that chocolate should coat the separate parts of the composite molded “club design.” See *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981)(“The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.”).

Accordingly, we reverse this ground of rejection.

Turning now to the combined teachings of Mackey, Kehoe, Wedin and Butcher, the issues in this ground of rejection involve the interpretation that one of ordinary skill would have made of certain disclosure of Mackey.⁷ Mackey corresponds to European Patent Application 0 603 467 discussed at length in the specification (brief, page 6), from which disclosure it is apparent that the reference does in fact disclose the process set forth in the limitations in appealed claim 14. In this respect, Mackey discloses that “a non-pourable fat-containing confectionery material, and in particular, a set chocolate, can be plasticized and extruded to produce a non-pourable product” (col. 2, lines 57-62). Indeed, Mackey teaches (col. 2, line 63,

⁷ It is well settled that a reference stands for all of the specific teachings thereof as well as the inferences one of ordinary skill in this art would have reasonably been expected to draw therefrom, see *In re Fritch*, 972 F.2d 1260, 1264-65, 23 USPQ2d 1780, 1782-83 (Fed. Cir. 1992); *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968), presuming skill on the part of this person. *In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985).

to col. 3, line 42)

a process for plasticizing and extruding a fat-containing confectionery material which comprises applying pressure to a fat-containing confectionary material, which is in a substantially non-pourable state, to pass it through a zone of convergence to plasticize it and extruding the material to obtain the material in a substantially non-pourable state. By proceeding in accordance with the process of the present invention, an axially homogeneous extruded product having a cross-section that is of substantially the same profile as a die orifice of an extruder from which it is extruded is obtained.

. . . .

The fat-containing confectionery material is most advantageously a chocolate, be it plain, milk or white chocolate, although caramel, toffee and butterscotch, for example, may be employed. Advantageously the material is in a granulated form, and chocolate buttons are especially preferred.

Surprisingly, it has been discovered that, particularly in the case of a set chocolate, the process of the present invention is substantially isothermal. It has been found that the temperature of the set non-pourable chocolate does not increase materially to effect a change in character from the non-pourable state, and in practice, the temperature may be found to remain substantially constant. . . . [T]he physical state of the chocolate is such that its general deformation behavior during extrusion alters only to that of a plastic nature rather than that of a viscous fluid, and since the product is “cold” extruded, cooling means typically employed for chocolate product preparation, such as cooling tunnels, are not necessary.

Mackey further teaches (col. 5, lines 27-44) that

[t]he extrusion die shapes provide for preparing solid or hollowed profiled products, e.g., bars, rods, spirals, twists, springs, hollow sections such as tubes and more complex shapes such as the letters of the alphabet, as well as thin films having a thickness which may be as little as 100 microns. . . .

Two or more fat-based materials may be co-extruded in accordance with the process of the present invention, and the fat-containing confectionary material may be co-extruded with other food materials, such as ice-creams, fondants, etc., such being advantageous when the fat-containing confectionery material is extruded in a hollow or tubular form. Hence, in such embodiments, a multi-orifice die and/or associated equipment, as are known to those skilled in the art, may be employed.

In Mackey Example 8, a FLORIN extruder with a centered “torpedo” position in the barrel produces “solid non-pourable hollow tubular sections,” and it is further disclosed that

[c]o-extrusion with fondant may be carried out by using a “torpedo” provided with a longitudinal channel through which the fondant flows to give a chocolate coated fondant. [Col. 8, lines 6-16.]

We find that one of ordinary skill in this art would have given the terms “co-extrusion”⁸ and “fondant”⁹ their ordinary dictionary meanings in considering the plain teachings of Mackey.¹⁰

In the brief, appellant acknowledges that “Mackey discloses processing a particulate starting material, which may be a chocolate, or caramel, or toffee, . . . [and] further discloses that two or more fat-based materials may be co-extruded and also that ‘the fat-containing material may be coextruded ‘with other food materials’, such as ice creams fondants etc., such being advantageous when fat-containing confectionery material is extruded in a hollow or tubular form’ by employing a multi-orifice die and/or associated equipment” (pages 7-8). In discussing the ground of rejection based on Mackey, appellant states that “it is not believed that there is any issue concerning whether or not Mackey co-extrusion would render the claimed products obvious,” and “should the understanding that the Mackey co-extrusion disclosure is not in issue be incorrect, it is requested that the Examiner so advise” (*id.*, page 20). After discussing the separate combinations of Mackey and each of Kehoe, Wedin and Butcher, appellant’s “Bottom Line” is that the position that “the Examiner has advanced in the context of the Mackey-based rejections is that someone . . . could have obtained a product with veins in it” which “is not what is claimed” (*id.*, page 22).

The examiner finds that “Mackey discloses coextruding two or more fat-based materials . . . [and] the use of toffee, caramel, and chocolate ‘buttons’ are disclosed,” and based on this disclosure, concludes that “[i]t would therefore have been obvious to co-extrude the chocolate and toffee or caramel chips or buttons of Mackey in the method of Mackey to produce a confection having *a single vein of toffee or caramel coated (i.e., within) chocolate* as desired,” noting that “Mackey teaches appellant’s extrusion process, with the *exceptions . . . of the presence of more than one vein within the chocolate*” (answer, page 5; emphasis supplied). The examiner then sets forth the view that in following the teachings of Mackey, the feeding of

⁸ See above note 3.

⁹ A “fondant” is “1. A sweet, creamy sugar paste used in candies and icings.” *Webster’s II New Riverside University Dictionary*, page 520.

particulate chocolate and particulate confectionery composition comprising a syrup into an extruder to form and extrude a mixture in a non-pourable state through a die “forms a *single vein* within the chocolate” (*id.*, pages 5-6; emphasis supplied). After discussing the teachings of veins or strands formed in confectionery compositions in Kehoe (“injecting a plurality of different liquid flavor/dye compositions into a substantially homogeneous gum base or into a laminated or coextruded composition;” abstract), Wedin (coloring or flavoring materials from “smaller extrusion tube **13**” are “injected into the ice cream moving through the large extrusion tube **11** as a plurality of ribbons;” page 2, left col., lines 49-62) and Butcher (variegated extruder product “made by feeding a first viscous product through a tube, rotationally introducing a second, different viscous product into the first one while preventing homogeneous mixing;” abstract), the examiner concludes that “[i]t would have been obvious to introduce the caramel or toffee buttons of Mackey downstream of the introduction of the chocolate buttons but upstream of the die *to form multiple veins within the matrix material as taught by each of Kehoe, Wedin or Butcher*” (answer, page 6; emphasis supplied). In response to appellant’s arguments with respect to the combinations of Mackey with each of the secondary references in the brief, the examiner states as to each that the claims differ from Mackey in the recitation of more than one vein, each of the secondary references disclose multiple, interspersed veins and thus it “would have been obvious to produce a desired design” (*id.*, pages 10 and 11). The examiner continues the “one vein” theory of the coextrusion process of Mackey in discussing appellant’s “Bottom Line” (*id.*, pages 11-12).

It is apparent that the examiner implicitly responded to appellant’s statement that “it is not believed that there is any issue concerning whether or not Mackey co-extrusion would render the claimed products obvious” (*see above* p. 8, discussing brief, page 20), by maintaining the “one vein” view of the process of Mackey where “two or more fat-based materials may be co-extruded” (*see above* p. 7, setting forth col. 5, line 36, in context). In response, appellant states in the reply brief (page 4) that

¹⁰ In considering the disclosure of a reference, the definition of a term or the meaning of a phrase must be construed within the context of the reference as interpreted by one of ordinary skill in this art. *See generally, In re Salem*, 553 F.2d 676, 682-83, 193 USPQ 513, 518-19 (CCPA 1977).

it is also reasonable to conclude that obtaining a product having a single vein, as asserted by the Examiner, from a mixture would be quite a feat. That is, how a “mixture” is processed in an extruder can provide in the extruder, and/or after extrusion through a die, a “single vein” is simply beyond the comprehension of undersigned counsel and is, it is submitted, quite at odds with what, based upon basic extrusion art, the person of ordinary skill would expect or predict.

Appellant then requests “that the Examiner provide a Supplemental Answer which explains why the newly advanced rationale finds basis in fact from the Mackey disclosure” (Id.).

We find it implicit in appellant’s statements in the reply brief that one of ordinary skill in the extrusion arts would have reasonably expected that the coextrusion of two or more fat-based particulate materials as clearly taught by Mackey (col. 5, lines 36-37; see also col. 2, lines 57-65), which would include chocolate, caramel and toffee (col. 3, lines 19-24), would inherently result in more than one vein of one of the fat-based materials interspersed in another fat based material. We agree with appellant’s position and thus apply Mackey alone to the appealed claims. Because our application of Mackey is materially different from the examiner’s “one vein” theory and it is apparent from appellant’s statements in the brief and reply brief that our position has not been directly addressed by any of appellant’s arguments, we denominate our affirmance of the examiner’s rejection of appealed claims 14 through 25, 38, 39, 41 and 42 based on Mackey as a new ground of rejection based on our authority under 37 CFR § 1.192(b) (1997).

Accordingly, we find that based on the teachings of Mackey alone, one of ordinary skill in this art would have reasonably selected a combination of chocolate, the preferred fat-based material, and at least one other disclosed fat-based material, such as toffee or caramel, and would have coextruded the combination of fat-based materials by forming a mixture in the extruder and extruding the mixture through the single die thereof (*see above* note 3) in order to form a non-pourable, chocolate candy product as taught by the reference, and thus would have arrived at the claimed non-pourable chocolate candy product as encompassed by appealed claim 14, rendering the same *prima facie* obvious under § 103(a). Therefore, the burden falls upon appellant to establish by effective argument or objective evidence that the claimed invention patentably distinguishes over Mackey, even though the rejection is based on § 103(a). *See, e.g., In re Best*, 562 F.2d 1252, 1254-56, 195 USPQ 430, 432-34 (CCPA 1977) (“Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or

substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. See *In re Ludtke*, [441 F.2d 660, 169 USPQ 563 (CCPA 1971)]. Whether the rejection is based on “inherency” under 35 USC 102, on “prima facie obviousness” under 35 USC 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO’s inability to manufacture products or to obtain and compare prior art products. [Footnote and citation omitted.]”).

With respect to appealed claim 41, which requires a particulate chocolate substitute comprising a cocoa butter replacement or a particulate chocolate analogue comprising a cocoa butter replacement, we agree with the examiner’s finding that such “cocoa butter substituents . . . [are] conventionally known . . . [as] admitted by appellant . . . on page 4 of the specification” (answer, page 6), which finding was not challenged by appellant (see brief, pages 19 and 23; reply brief in its entirety). See generally, *In re Ahlert*, 424 F.2d 1088, 1091-92, 165 USPQ 418, 420-21 (CCPA 1970). With respect to claim 23, Mackey discloses that “the fat-containing confectionary material may be co-extruded with other food materials” and does not require that “the fat-containing confectionery material [is] extruded in a hollow or tubular form” when such materials are included, only that it is “advantageous” to do so (col. 5, lines 37-42). See *In re Lamberti*, 545 F.2d 747, 750, 192 USPQ 278, 280 (CCPA 1976) (“The fact that a specific [embodiment] is taught to be preferred is not controlling, since all disclosures of the prior art, including unpreferred embodiments, must be considered.”).

Accordingly, in view of the *prima facie* case of obviousness thus made out with respect to appealed claims 1 through 4 and 9 through 12, the burden of going forward has shifted to appellant to submit argument and/or evidence in rebuttal. See generally, *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

We have again carefully evaluated all of the evidence of obviousness and nonobviousness based on the record as a whole, giving due consideration to the weight of appellant’s arguments of record, including the submission of samples based on the Hershey *Symphony*® chocolate candy product,¹¹ as they pertain to the new ground of rejection which we have entered above.

¹¹ Letter filed July 23, 1998 (Paper No. 14).

We noted above that appellant has not addressed the rejection as stated here in the brief or reply brief. Pursuant to questions from the bench at oral hearing with respect to the manner in which Mackey is applied here, counsel advanced the view that Mackey could not be so interpreted, stating that the term “co-extruded” appearing at col. 5, line 36, meant that there were separate extruders and separate dies for each of the fat-based materials, and further that the additional materials were only added when the fat-based material, chocolate, was extruded in a hollow tube, pointing to col. 5, lines 38-44, and Example 8, wherein fondant is co-extruded with chocolate to provide a chocolate coated fondant. The difficulties with appellant’s oral arguments are first, that it is contrary to the art recognized definition of the term “coextrusion” which involves forming a mixture in a single extruder and extruding the mixture through a single die (*see above* note 3), and second, Mackey teaches that the extrusion of chocolate in a hollow tube and the use of multi-orifice dies is merely “advantageous,” not required, when such food materials as the creamy sugar-pastes or fondants (*see above* note 9) are coextruded with the chocolate as we discussed above, citing *Lamberti*.

With respect to the submission of the samples from the Hershey *Symphony*® chocolate candy product, this evidence is mentioned in the brief (pages 13-14) but is not argued with respect to Mackey. After the examiner again set forth the position in the answer that this “product was . . . [not] considered relevant in view of the newly amended claims” (page 7), appellant merely contends in the reply brief that the product “cannot be dismissed because it is part of the prior art and provides evidence of the state of the art” (page 3; see also pages 6-7), and again does not submit argument or objective evidence explaining the practical significance of the comparison to the teachings of Mackey as applied above, or indeed to any of the references applied by the examiner. It is well settled that the burden of establishing the practical significance of data in the record with respect to unexpected results rests with appellant, which burden is not carried by mere arguments of counsel. *See generally, In re Geisler*, 116 F.3d 1465, 1470, 43 USPQ2d 1362, 1365-66 (Fed. Cir. 1997); *In re Merck & Co.*, 800 F.2d 1091, 1099, 231 USPQ 375, 381 (Fed. Cir. 1986); *In re Longi*, 759 F.2d 887, 897, 225 USPQ 645, 651-52 (Fed. Cir. 1985); *In re Lindner*, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972) (“This court has said . . . that mere lawyers’ arguments unsupported by factual evidence are insufficient

to establish unexpected results. [Citations omitted.]”); *In re Klosak*, 455 F.2d 1077, 1080, 173 USPQ 14, 16 (CCPA 1972); *In re D’Ancicco*, 439 F.2d 1244, 1248, 169 USPQ 303, 306 (CCPA 1971).

Accordingly, having reconsidered the evidence of record in light of appellant’s arguments of record as they pertain to the new ground of rejection which we have entered above, we remain of the opinion that the claimed invention encompassed by appealed claims 14 through 25, 38, 39, 41 and 42 is *prima facie* obvious over the teachings of Mackey. Thus, the burden of going forward with respect to this ground of rejection remains with appellant. *See Piasecki, supra*.

The examiner’s decision is affirmed.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, “A new ground of rejection shall not be considered final for purposes of judicial review.”

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

37 CFR § 1.196(b)

CHARLES F. WARREN
Administrative Patent Judge

LINDA R. POTEATE
Administrative Patent Judge

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) APPEALS AND
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KRATZ, *Administrative Patent Judge*, dissenting.

I respectfully disagree with the majority's reversal of the examiner's § 103 rejection of claims 14-25, 38, 39, 41 and 42 as being unpatentable over Pelletier in view of Cloud and, if necessary, appellant's admission at page 4 of the specification. While I concur with the majority's conclusion in affirming the examiner's § 103 rejection of the appealed claims before us based on Mackey, I would do so on a different basis. In this regard, I disagree with the majority's implicit reversal of the examiner's § 103 rejection of claims 14-25, 38, 39, 41 and 42 as being unpatentable over Mackey taken with Kehoe, Wedin or Butcher with or without the admitted prior art.¹² Moreover, I disagree with the majority's reasoning and reliance on statements in appellant's reply brief as implicit support for the majority's view as to what Mackey teaches in affirming the examiner's § 103 rejection of claims 14-25, 38, 39, 41 and 42 as being unpatentable over Mackey in view of either Kehoe, Wedin or Butcher, each, if necessary, in view of appellant's admission at page 4 of the specification, while denominating their affirmance as a new ground of rejection under 37 CFR § 1.192(c)(7)(1997).

Upon careful consideration of the opposing arguments presented on appeal, I concur with the examiner that the claimed subject matter would have been obvious to one of ordinary skill in the art within the meaning of 35 U.S.C. § 103 in view of the applied prior art. More specifically, I consider the reference evidence adduced by the examiner when considered together with the examiner's analysis to have set forth a reasonable basis for concluding that one with ordinary skill in the art would have combined the applied prior art teachings in a manner so as to thereby result in a product which corresponds to the here claimed product. The arguments set forth in the briefs expose no reversible error on the examiner's part in reaching this obviousness conclusion. Accordingly, it is my judgment that both of the examiner's § 103 rejections should be sustained.

While the appealed claims describe the product, at least partially, in terms of the method by which it is made, it is the finished product, not the method of making the product, that is the appropriate focus of inquiry since the patentability of such claims is determined based on the product itself. *See In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985) ("If the

¹² In denominating their affirmance as a new ground of rejection under 37 CFR § 1.192(c)(7)(1997), the majority implicitly reverses the examiner's § 103 rejection based on Mackey together with the other cited secondary references and admitted prior art.

product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process.")

Where, as here, the examiner reasonably establishes that appellant's product and that suggested by the applied prior art appear to be substantially identical, the burden shifts to appellant to provide evidence that the suggested product of the applied prior art does not possess any relied upon characteristics that are necessarily a part of appellant's claimed product. *See In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980); *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-434 (CCPA 1977); *In re Fessmann*, 489 F.2d 742, 745, 180 USPQ 324, 326 (CCPA 1974). The reason is that the Patent and Trademark Office is not able to manufacture and compare products. *See Best, supra*; *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972).

Here, it is my view that appellant primarily argues for the patentability of the appealed claims based on alleged method differences rather than persuasively arguing in the briefs, let alone establishing with objective evidence commensurate in scope with the claims, how the products of the appealed claims are necessarily patentably distinguished over the products suggested by the applied prior art relied upon in the separate rejections advanced by the examiner. It is worth noting that the process by which the claimed product is made is set forth in "comprising" language. See representative claim 14, on which I would decide this appeal. Thus, the process by which the claimed product is made is open to other process steps. Indeed, appellant explicitly describes many other process steps which may be employed, such as in the paragraph bridging pages 5 and 6 of the specification. In examining that carryover paragraph, it becomes clear that the claimed product is inclusive of products that are obtained from the extrudate by further processing the extrudate after removal from the die of representative claim 14. For example, that extrudate, which may contain as few as two small veins or strands of syrup containing confectionary material¹³, or only two relatively fat veins thereof stuffed therein¹⁴, can

¹³ The representative claim does not require that any more than a small fleck or two of particulate syrup containing confection be used - enough to form two small streaks or veins thereof inserted or interspersed in the chocolate.

¹⁴ While appellant seemingly urges otherwise, appellant has not established with objective evidence that the term interspersed as used in the extrusion step in making appellant's product

be further manipulated such as by cutting, scraping, having other materials added thereto and/or being homogenized and/or injection molded or otherwise treated alone or with other materials that are added. Indeed, representative claim 14 is open to other materials being added in amounts that would dwarf the chocolate or syrup containing confection in the extrudate. Given that claim breadth, it can hardly be said that the ultimately obtained claimed product requires any particular vein arrangement such that it necessarily would be patentably distinct from the products suggested by the applied prior art based on the arguments appellant presents in the briefs. In this regard, appellant argues for patentability of the claimed product as if that product is required to have particular type veins (comet shape) and random or non-patterned arrangement thereof in the chocolate (interspersed) that would differentiate over Pelletier taken with Cloud with or without the admitted prior art or differentiate over Mackey with Kehoe, Wedin or Butcher with or without the admitted prior art. However, those arguments, as well as the sample product submitted in the record (Paper No. 14), are clearly not commensurate in scope with the claimed subject matter for reasons as discussed above and as set forth by the examiner in the answer.

While I agree with the majority that the teachings of Mackey alone seem sufficient to render the claimed subject matter *prima facie* obvious, I do not find implicit support in appellant's statements in the reply brief (i.e., an admission) for bolstering such a position as the majority apparently suggests in their opinion. Moreover, I agree with the examiner that the combined teachings of Mackey with the secondary references relied upon by the examiner would have rendered the claimed product obvious within the meaning of 35 U.S.C. § 103. Concerning this matter, whether or not the examiner's reasoning is complete and fully correct with regard to the so called "single vein" theory in describing the teachings of Mackey, it is clear that Mackey alone or in combination with the secondary references relied upon by the examiner reasonably suggests forming an extrudate from a mixture of chocolate and syrup based confectionary material, such as caramel or toffee so as to obtain a striated appearance in a snack food item.

necessitates that the final product, as claimed, has any particular veined structure, let alone veins which are inlaid in the chocolate in a non-touching manner so as to patentably differ from the modified Pelletier molded chocolate advanced by the examiner as a basis for rejecting the claimed subject matter.

It is well settled that in evaluating a reference, all of the disclosure of the reference must be considered for what it fairly teaches or would have suggested to one having ordinary skill in the art. *See In re Boe*, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Thus, it is proper to take into account not only specific teachings of the reference, but also the inferences which one skilled in the art would reasonably be expected to draw from the disclosure. *See In re Preda*, 401 F.2d 825, 826-27, 159 USPQ 342, 343-44 (CCPA 1968). Certainly, it would have been *prima facie* obvious to one of ordinary skill in the art to use two of the fat containing confectionary materials listed by Mackey together to obtain a food product with their combined ingredients based on Mackey's teaching that each may be used alone or co-extruded.

Accordingly, I would affirm both of the examiner's § 103 rejections.

PETER F. KRATZ
Administrative Patent Judge

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